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09/487,233

01/19/2000

Scott D. Cook

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EXAMINER

DASS, HARISH T

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 09/487,233 | Applicant(s) COOK ET AL. | |
| | Examiner Harish T. Dass | Art Unit 3693 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8, 19, 26, 33, 36, 38, 39, 45, 46, 65, 66, 71, 87, 88 and 102-106 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 19, 26, 33, 36, 38-39, 45-46, 65-66, 71, 87-88, 102-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/01/2007 has been entered.

Status of Claims:

Claims 5, 9-18, 20-25, 27-32, 34-35, 37, 40-44, 47-64, 67-70, 72-86 and 89-101 are cancelled.

Pending 1-4, 6-8, 19, 26, 33, 36, 38-39, 45-46, 65-66, 71, 87-88, 102-106.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-8, 19, 26, 33, 36, 38-39, 45-46, 65-66, 71, 87-88, and 102-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deming (US Patent 4,823,264) in view of Thomas et al (hereinafter Thomas, US 6173,272), Buck, S. Peter, 1997 "From electronic money to electronic cash: payment on the Net", Logistics

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Information Management. Bradford: 1997.Vol.10, Iss. 6; pg. 289. Periodical ISSN/ISBN: 09576053; ProQuest document ID: 86066773.

Re. Claim 1, Deming discloses an electronic fund transfer (EFT) system and method for transferring funds from payer's account to Payee or to Payee's account using National Automated clearing House Association (ACH) facility, [Abstract; Col. 3 lines 3-12], and receiving from the sender an amount of a funds transfer, a designation of a source account for the funds transfer, and the host system providing a first instruction to the host financial institution to cause the transfer of funds from the source account [Col. 3 lines 3-29; Col. 3 line 63 to Col. 4 line 11; Col. 4 lines 30-59].

Deming, does not explicitly disclose a host system operating on a conventional computer system and communicatively coupled to a host financial institution that is an automatic clearinghouse (ACH) member at which is maintained a host account,

receiving from the receiver the designation of the target account for receiving the funds from the sender,

contact information of the receiver sufficient for contacting the receiver, without receiving from the sender a designation of a target account of the receiver,

the host system contacting the receiver using the information provided by the sender, and informing the receiver that the sender is capable of initiating a transfer of funds to the receiver, and after the host system has contacted the receiver using the information provided by the sender.

The host system providing a first instruction to the host financial institution; the host system providing a second instruction to the host financial institution to cause the transfer of the funds from the host account to the target account;

Wherein any of the first instruction and the second instruction effects through an ACH network a number of ACH entities to transfer funds; and wherein the sender is not required to have a previously established ACH originator relationship with an ACH member at which the sender's source account is maintained.

However, ACH is well known where electronic entries received the ACH from depository financial institutions (members) are processed for settlement.

Thomas discloses receiving from the receiver the designation of the target account for receiving the funds from the sender [Abstract; Figure 1, 2A, 3, 7; Col. 3 line 45 to Col. 5 line 34; Col. 15 lines 1-30]; the host system providing a first instruction to the host financial institution to cause the transfer of funds from the source account to host account (or account) [Figure 2A; Col. 1 lines 60-65];

the host system providing a second instruction to the host financial institution to cause the transfer of the funds from the host account to the target account [Col. 6 lines 22-23; Col. 29 lines 33-40; claim 26];

Wherein any of the first instruction and the second instruction effects through an ACH network a number of ACH entities to transfer funds [Figure 2 – the transfer path in a network can be through many point for example, bank to second bank, to Fed-Reserve, etc.];

wherein the sender is not required to have a previously established ACH originator relationship with an ACH member at which the sender's source account is maintained [Col. 8 lines 35-46; Col. 22 lines 40-52 – see CHIPS, NYACH], and contact information of the receiver sufficient for contacting the receiver, without receiving from the sender a designation of a target account of the receiver [col. 3 lines 4-12 ; col. 3 line 64 to col. 4 line 3 (note: C-B account number or BRN are not the target account number, which includes a routing/transit number and an account number. It is simple a customer number assigned by the biller - col. 2 lines 12-19)], and the host system contacting the receiver using the information provided by the sender, and informing the receiver that the sender is capable of initiating a transfer of funds to the receiver, and after the host system has contacted the receiver using the information provided by the sender [Col. 1 lines 46-66 “In recent years ... payment instruction ... paper check ... deposit in to biller’s bank account in bank B” col. 3 lines 9-13, & line 55 to col. 4 line 3 “Thus, ... without ... account number ... payors electronically ... information”. col. 4 lines 43-55 “The trusted third party ... to identify the payee as a party ...” col. 5 lines 18-33 “communicate (contacting) with both...”, note: trusted party communicating with payee’s bank inherently getting payee’s account information from payee’s bank and transferring the fund to that account, otherwise why bother to communicate with payee’s bank, simply mail the check to the payee and let him/her to deposit the check or mail the check to payee’s bank if the address is payee’s bank] to uniquely identify the confidential information of the biller (target account) based on name and address provided by the payor and the communication with bank of payee.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Deming and include the above EFT steps disclosed by Thomas to facilitate electronic fund transfer using electronic home banking system that protects the security of bank customers and their banks proprietary interests, without unnecessarily distributing information regarding bank affiliation or account number by uniquely identify the confidential information of the biller (target account) based on name and address provided by the payor.

Peter disclose receiving from the receiver the designation of the target account for receiving the funds from the sender [see entire document (13 pages) particularly pages 2-7] to allow user to make payment over the internet and transfer funds between individuals. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify disclosures of Deming and Thomas and include receiving from the receiver the designation of the target account for receiving the funds from the sender, as disclosed by Peters, to facilitate proper transfer of funds between accounts of the payor and destination account (target account) where the receiver wants the fund to be transferred and avoid costly errors.

Re. Claims 2-3 Deming discloses wherein the designation of the source account includes a routing/transit number and an account number (payor's routing and transfer number - RTN) [Col. 3 lines 15-16] and wherein the designation of the source account includes a routing/transit number and an account number (payee's routing and transfer number - RTN) [Col. 3 line 33].

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Re. Claims 4, 6-7, Deming disclose receiving the amount of the funds transfer (bill). Deming, explicitly, does not disclose receiving the amount of the funds transfer, the designation of the source account for the funds transfer, and the contact information of the receiver from the sender [Col. 1 line 5 to Col. 3 line 8]. Deming, explicitly, does not disclose the way the bill is received (i.e. by email, web page, etc.). However, Thomas further discloses these steps [Col. 3 lines 14-23]. Mail, Email, voice mail, voice over IP, on-line billing and pager are well known to one skill in the art as a common communication media used by the billers to communicate with customers, therefore one can combine the teaching of Doming, Thomas, and Peter to present electronic bill information by electronic media, explained above, instead of regular mail to save time reduce cost.

Re. Claims 66, claim 66 is substantially similar to claim 1, therefor it is rejected with same rational as claim 1.

Re. Claims 8, 19, 26, 33, 36, 38, 39, 45, 46 and 65 Deming discloses an electronic fund transfer (EFT) system/method/computer from payer's account to Payee or to Payee's account using National Automated clearing House Association facility, routing and transfer number, transaction amount, payer starts initiating EFT using PC and entering payee information (target information), identification code, description of transaction (bill identification), crediting the debiting accounts, means for verifying payers account code [Fig. 1; Col. 1 line 1 to Col. 4 line 67]. Thomas further discloses electronic funds transfer and bill presentment. Both Deming and Thomas substantially recite claims features. Deming, Thomas, or Peter, explicitly does not

disclose continuing the funds transfer if the first account balance and second account balance match, and continuing the funds transfer if the check amount match. However, this is obvious that the bank transfers only if the sender account has money, if the balance is below of the amount of the sender's instruction (payment amount or check) the payment is done and this function is inherent part of the banking, and similarly auditing the amount is inherent function of banking to avoid wrong payment. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify the disclosures of Deming, Peter and Thomas and include continuing the funds transfer if the first account balance and second account balance match, and continuing the funds transfer if the check amount match to properly and accurately transfer the funds to receiver.

Re. Claims 71 and 87-88, claims 71 and 87-8 are substantially similar to claims 1 and 66, therefore, Claims 71 and 87 are rejected under the same rational as claims 1 and 66.

Re. Claims 102-106, Deming discloses receiving a first amount from the sender regarding a financial transaction, wherein the financial transaction is associated with the source account, comparing the first amount with a second amount, wherein the second amount is associated with the source account; and authenticating the sender based on at least comparing the first amount with the second amount [Col. 1 lines 38-56; Col. 3 lines 48-55].

Response to Arguments

Applicant's arguments with respect to amended limitation have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Harish T Dass
Examiner
Art Unit 3693



05/25/06